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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/666,048

09/18/2003

Deepak Tandon

A03148US (98786.5)

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7590

02/22/2008

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EXAMINER

HENDRICKSON, STUART L

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

02/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,048	<b>Applicant(s)</b> TANDON ET AL.	
	<b>Examiner</b> Stuart Hendrickson	<b>Art Unit</b> 1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 4-7, 10-16 and 26-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 9, 17-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The RCE is accepted.

Claims 2, 18-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) In claim 2, it is not clear how a carbon black can be from both groups.
- b) Claim 24 contains improper Markush language. 'a' group is improper.
- c) Claim 19 is unclear as to what 'stronger structure' means.
- d) Claim 20 is unclear, as FDA requirements can change. Perhaps 'generally recognized as safe' is meant.
- e) Claims 18, 19 and 21-25 are unclear as to the basis for comparison. Compared to which ones? The word 'regular' appears only in claim 19. What does it mean and why is this claim differently worded? Does claim 18 (for example) imply that the present carbon blacks have higher conductivity than any previously existing carbon black ever?

Claims 1-3, 8, 9, 17-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshimura et al. 4693879.

The reference teaches, in the entire document but in col. 8 and 9 especially, carbon black having the claimed properties subject to heat treatment. The intended use does not limit the product. Although the heat treatment is not identical to what is claimed, where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. No difference is seen in the effect of the treatment (claim 9).

Claims 1-3, 8, 9, 17-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson 3408164.

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The reference teaches, in the entire document but in col. 8 and 9 especially, carbon black having the claimed properties subject to heat treatment. The intended use does not limit the product. Although the heat treatment is not identical to what is claimed, where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. No difference is seen in the effect of the treatment (claim 9).

Applicant's arguments filed 1/18/08 have been fully considered but they are not persuasive.

Concerning the '112 rejections, the specification portion cited (the details left blank should be inserted) does not describe how a carbon black can be a thermal AND furnace black. Given that applicant is treated carbon blacks made by others, it does not seem that this would impart patentability. The examiner sees from the specification how the original carbon black can be a thermal OR furnace black, but this is not claimed. Claim 20 is not clear as to when 'current' refers to. The filing date of the specification? 1/28/08? 2/19/08? Some unspecified date in the future? The examiner's suggested language should be adopted. Claims 18, 19 and 21-25 have not been amended since the rejection was made.

Concerning Yoshimura, claim 1 (for example) does not require any particular temperature. Even if it did, it is a product claim and no difference is seen in the actual product. The claims do not recite d002 or any property indicative of the degree of graphitization, so the arguments are not persuasive. The high temperature of Johnson would seem to cause graphitization and the S content is not claimed.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.

/Stuart Hendrickson/

Stuart Hendrickson  
examiner Art Unit 1793